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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/826,728      | 04/05/2001  | Tim Mortenson        | 120051-1006         | 6052             |

7590 11/08/2004

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EXAMINER

GRANT II, JEROME

ART UNIT PAPER NUMBER

2626

DATE MAILED: 11/08/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/826,728

Applicant(s)

MORTENSON ET AL.

Examiner

Jerome Grant II

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

JEROME GRANT II  
PRIMARY EXAMINER

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

### **Detailed Action**

1.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-21 are rejected under 35 U.S.C. 102(e) as being anticipated by Hada.

With respect to claim 1, Hada shows an apparatus, shown by figure 1, for processing one or more documents, (see paragraph 74 lines 1-4), comprising: a color scanner 1 for creating an image of each document, see paragraph 107; a memory (inherent by paragraph 107, lines 21-23) for storing one or more document processing instructions (see para. 110 lines 6-11) associated, with the presence or absence of one or more color swatches (standard pattern see also para. 107, lines 8-11; and a processor (unit 42) coupled to the color scanner 1 and the memory, the processor

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controlling the color scanner, determining whether one or more color swatches are present or absent in the image and executing the document processing instructions associated with the presence or absence of the one or more color swatches. Note pattern discrimination 104 for determining if the pattern is present or not, see para. 84.

With respect to claims 2 and 12, Hada teaches a processor which removes the one or more color swatches from the image. This occurs when second or later generation copies are made, see para. 110, lines 21-24.

With respect to claims 3 and 13, Hada teaches a storage device (CCD 3 or photosensitive member for storing the image on a drum).

With respect to claims 4 and 14, Hada teaches the amount of color correction conditions indicated how much of C, M, Y, K of the image will be stored in the form of toner on the recording drum. See para. 110, lines 1-20.

With respect to claims 5 and 15, Hada teaches the image is stored inside the image forming area, according to paragraph 107, lines 7-9.

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With respect to claim 6, Hada further teaches a document sorter (25 and 30) coupled to the processor 42 (although indirectly); a document feeder (series of rollers for advancing a document that has at least one of C, M, Y, K images thereon, coupled to the color scanner, the processor 42 and the document sorter (25 and 30); and the processor 42 further controlling the document sorter (25 and 30) and the feeder( see the series of rollers shown by the portion of unit 20 in figure 1).

With respect to claims 7 and 17, Hada teaches the document processing instructions indicates how the documents are sorted. This occurs when the type of color conditions will be applied to all documents with the documents sorted for C,M,Y and K toner adhesion for each composite rendition.

With respect to claims 8 and 18, Hada teaches preprinted color swatches in that the swatches are pre-printed with respect to the second and later generation copes, see para. 110, lines 20-25.

With respect to claims 9 and 20 , Hada teaches the swatches are applied mechanically because the printer prints the standard pattern, see para. 110, lines 7-10.

With respect to claims 10 and 21, this limitation is inherent with respect to Hada in that it is inherent to take a printed swatch, according to para. 110, lines 7-10 and affix or apply it to a region outside the read region as suggested by figure. 6. for example.

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With respect to claim 11, Hada teaches creating an image of each document, via scanner 1; memory at para. 107, lines 21-24, for determining whether one or more color swatches are present or absent in the image, see also para. 107 and lines 8-11; and processor 42 for performing the method step of executing one or more document processing instructions associated with the presence or absence of a swatch.

Hada teaches, the processor controlling the color scanner, determining whether one or more color swatches are present or absent in the image and executing the document processing instructions associated with the presence or absence of the one or more color swatches. Note pattern discrimination 104 for determining if the pattern is present or not, see para. 84

With respect to claim 16, Hada teaches color conditions are obtained and imaging is determined based upon a color determination, by color determination unit 105. Thus a document at printing will be sorted to accommodate a black rendition not using C, M and Y but on the other hand, a color reproduction will sort the document to utilize at least all of the C, M, Y color toner rendering.

With respect to claim 19, see figure 6 or paragraph 107, lines 6-11 which teaches applying swatches to the image.

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2.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 22-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hada in view of Odagiri.

Hada shows an apparatus, shown by figure 1, for processing one or more documents, (see paragraph 74 lines 1-4), comprising: a color scanner 1 for creating an image of each document, see paragraph 107; a memory (inherent by paragraph 107, lines 21-23) for storing one or more document processing instructions (see para. 110 lines 6-11) associated, with the presence or absence of one or more color swatches (standard pattern see also para. 107, lines 8-11.; and a processor (unit 42) coupled to the color scanner 1 and the memory, the processor controlling the color scanner, determining whether one or more color swatches are present or absent in the image and executing the document processing instructions associated with the presence or absence of the one or more color swatches. Note pattern discrimination 104 for determining if the patter is present or not , see para. 84.

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What Hada does not specifically show is the a computer program embodied in a memory having code to perform the previously mentioned steps.

Odagiri teaches a memory (ROM/RAM 20) for storing a program run by CPU 1 for extracting color patches , see para. 94 and 97. Para. 97 refers to a specific application stored in memory 20 for extracting color patch information.

While Odagiri does not teach the specifics of Hada, one of ordinary skill would have know to use software in a memory for finding a color patch and processing color image information just as specifically set forth by Odagiri at para. 94 and 97.

It would have been obvious to one of ordinary skill in the art to modify the scanner of figure 6 of Hada with a ROM having software to run the process of color imageing as is performed by Odagiri, for the purpose of processing and color correcting image data.



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With respect to claim 23, Hada teaches a processor which removes the one or more color swatches from the image. This occurs when second or later generation copies are made, see para. 110, lines 21-24.

With respect to claim 24, Hada teaches a storage device (CCD 3 or photosensitive member for storing the image on a drum).

With respect to claim 25, Hada teaches the amount of color correction conditions indicated how much of C, M, Y, K of the image will be stored in the form of toner on the recording drum. See para. 110, lines 1-20.

With respect to claim 26, Hada teaches the image is stored inside the image forming area, according to paragraph 107, lines 7-9.

With respect to claim 27, Hada further teaches a document sorter (25 and 30) coupled to the processor 42 (although indirectly); a document feeder (series of rollers for advancing a document that has at least one of C, M, Y, K images thereon, coupled to the color scanner, the processor 42 and the document sorter (25 and 30); and the processor 42 further controlling the document sorter (25 and 30) and the feeder (see the series of rollers shown by the portion of unit 20 in figure 1).

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With respect to claim 28, Hada teaches the document processing instructions indicates how the documents are sorted. This occurs when the type of color conditions will be applied to all documents with the documents sorted for C,M,Y and K toner adhesion for each composite rendition.

With respect to claim 29, Hada teaches preprinted color swatches in that the swatches are pre-printed with respect to the second and later generation copes, see para. 110, lines 20-25.

With respect to claim 30, see figure 6 or paragraph 107, lines 6-11 which teaches applying swatches to the image.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jerome Grant II whose telephone number is 703-305-4391. The examiner can normally be reached on Mon.-Fri. from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A Williams, can be reached on 703-305-4863. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

J. Grant II



JEROME GRANT II  
PRIMARY EXAMINER